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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DAVID M. GOLDENBERG

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Appeal 2010-007334
Application 09/313,278
Technology Center 2100

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Before: ALLEN R. MACDONALD, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 39-51. Claims 1-38 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Appellant's invention is directed generally to accessing medical information and management. More particularly, the invention on appeal is directed to "an interactive virtual doctor system using a network." (Spec. 1).

Claim 39, reproduced below, is illustrative of the claimed subject matter:

39.   A method of providing one of the group consisting of medical, veterinary, and other health care information on subjects of interest to a user, the method comprising:

accepting an inquiry from the user;

determining a level of service based on the user inquiry; and if the level of service is a first level of service:

determining a user sophistication based on the user inquiry;

searching a database at an initial level using the search request, in order to identify information requested in the user inquiry;

conditioning the search results based on the user sophistication; and

providing the conditioned search results at the initial level to the user.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Nicol   US 5,287,448   Feb. 15, 1994
Douglas   US 6,039,688   Mar. 21, 2000
                                                     (Filed Oct. 31, 1997)

The Examiner's taking of Official Notice.

REJECTIONS

Claims 39-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Douglas and Nicol.

Claim 51 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglas and the Examiner's taking of Official Notice.

FINDINGS OF FACT (FF)

1. Douglas teaches a rewards point system. (Col. 14, l. 40).

2. Douglas teaches database searches that locate more information, such as a list of articles and Internet sites devoted to providing medical and health-related information. (Col. 16, ll. 21-55).

3. Fig. 48 of Douglas teaches a level of service in which a user (Fred) is provided with a list of health care professionals (Susan).

4. Nicol teaches:
   The present method provides messages which are context sensitive. Context refers to the program's state at the time of the request-what operation was being performed, what was displayed to the user, the selected items on the display, the

current state of the computer, etc. Another element of
context can be the type of help requested. For example, the
user may *specify that help requests look for the answer to
one of a variety of questions*. Still another element of the
context can be the *user's level of sophistication*.
Sophistication means the relative familiarity of a user with a
program or operation. The present invention provides *more
detailed explanations to more sophisticated users, and more
general messages to the less sophisticated user*. By using
context, the present invention can retrieve and display
appropriate messages to aid the user.

(Col. 2, ll. 32-47, emphasis added).

5. Nicol teaches different levels of options (novice, moderate,
or experienced) to be selected by the user. (Col. 8, l. 36).

PRIOR DECISION

Appeal No. 2007-0275, (Application No. 09/313,278) mailed June 29,
2007. (Reversing Examiner's §102(e) rejection of claims 39-50 over
Douglas and reversing the Examiner's §103 rejection over Douglas in view
of Official Notice).

ANALYSIS

We consider Appellant's arguments *seriatim* as they are presented in
the principal Brief, pages 3-7.

Independent claim 39

Issue: Under § 103, did the Examiner err in finding that the cited
references, either alone or in combination, would have taught or suggested
the following disputed limitation: "determining a user sophistication based
on the user inquiry," within the meaning of independent claim 39?

Regarding independent claim 39, Appellant contends that "[u]ser
sophistication in the present invention is determined 'based on the user

inquiry,' and this feature would not have been suggested by the combination of Douglas et al. and Nicol et al." (App. Br. 3). In support, Appellant points to a portion of the Specification which describes a *processor* (Spec. 10, l. 3) that accesses a database of medical definitions to provide an appropriate response to a user. (App. Br. 4). Appellant further contends:

> The examiner proposes to substitute a feature from Nicol, in which the user selects a sophistication level from a pull-down menu, into the behavior modification program of Douglas. Selection of sophistication level by the user from a pull-down menu is *quite different* from the situation in which the *processor* assesses a user inquiry and "determine[s] a user sophistication based on the user inquiry." In one case, sophistication level is determined by the processor based on the user's inquiry, while in the other case, sophistication level is determined by the user. This feature of determining sophistication level based on user inquiry is nowhere to be found in the combination of Douglas and Nicol. Even when the two references are combined as in the rejection, the result is not the same as that which is set forth in claim 39.

(App. Br. 4, emphasis added).

However, we observe that the method of claim 39 does not recite who or what performs the steps of the method. In particular, claim 39 is silent regarding the argued *processor*. (App. Br. 4). We decline Appellant's invitation to read limitations from the Specification into the claims.[1] Moreover, Appellant's arguments fail to address the Examiner's broader

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[1] Patentability is based upon the claims. "It is the claims that measure the invention." *SRI Int'l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*). A basic canon of claim construction is that one may not read a limitation into a claim from the written description.

construction that is expressly stated in the rejection of claim 39: "[a]ny communication made by the physician or patient to the system interface is considered an inquiry from a user." (Ans. 3).

Because the argued processor is not claimed, and because Appellant has not addressed the Examiner's broader construction, on this record, we are not persuaded of Examiner error. We also observe the Examiner additionally finds that Nicol teaches different levels of options (novice, moderate, or experienced) to be selected by the user in the (combined) system with Douglas. (Ans. 6, *See* FF 5).

Regarding the combinability of the Douglas and Nicol references, Appellant contends that combining the therapeutic behavior modification program of Douglas with Nicol "would be contrary to the purpose of the Douglas program, which is to provide milestones by which users can judge their progress in achieving certain goals, such as weight loss or exercise levels." (App. Br. 4).

However, we find Appellant's argument unpersuasive for the reasons we stated in our prior Decision (directing the Examiner's attention to Nicol):

> U.S. Patent 5,287,448 to Nicol (1994) [] teaches a method and apparatus for providing help information to computer users. Nicol teaches a method of providing messages that are context sensitive (col. 2, ll. 32-33). In particular, Nicol discloses that context elements can be the *type of help requested by the user* as well as the *user's level of sophistication* (col. 2, ll. 37-41).

Renishaw plc v. Marposs Societa' per Azioni, 158 F.3d 1243, 1248 (Fed. Cir. 1998).

> We conclude that Douglas at least suggests a need for different
> levels of medical information to be provided to different
> categories of users (*see* Douglas at col. 5, ll. 60-61: "The
> members of the wellness group may not need all the features
> available to members of the clinical group").

(Prior Decision 2007-0275, mailed June 29, 2007 (pp. 7-8); *see also* FF 4 *supra*).

For the aforementioned reasons, we sustain the Examiner's rejection of independent claim 39.

Dependent claims 40-42, 46, and 48

Regarding Appellant's remaining contentions regarding the recited second, and third levels of services (App. Br. 5-6), we agree with and adopt the Examiner's underlying factual findings (FF 1-3) and ultimate legal conclusion of obviousness, as set forth in the rejection (Ans. 3-5), and further explained in the "Response to Arguments" section of the Answer (7). For these reasons, and for the reasons discussed above regarding independent claim 39, we sustain the Examiner's rejection of dependent claims 40-42, 46, and 48.

Dependent claim 51

Claim 51 recites: "The method of claim 49, wherein administering treatment to the user comprises transmitting instructions over a network to perform remote surgery."

We agree with the Examiner's taking of "Official Notice" that the concept of having a physician ask a patient to undergo surgery is notoriously well known in the context of physician-patient interaction, and that it would

have been obvious to modify Douglas to include a recommendation to the remote patient that the patient undergo surgery so as to improve the patient's health. (Ans. 7-8).

Appellant avers that "such recommendation is not 'administering treatment' and it is not the transmission of signals over a network that relate to the *actual performance* of remote surgery, as presently claimed" (App. Br. 7, emphasis added).

However, we observe that the argued *actual performance of remote surgery* is not positively recited. (Claim 51). Moreover, the informational content of the transmitted *instructions* is non-functional descriptive material.[2] The informational content of such instructions is intended for a human recipient (user) and does not affect the manner in which the step of transmission is performed, nor does such instruction content otherwise alter or change any machine or computer function. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential); *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (informative) (Federal Circuit Appeal No. 2006-1003, *aff'd*, Rule 36 (June 12, 2006)); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative), *aff'd*, 191 Fed. Appx. 959 (Fed. Cir. 2006).

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[2] *Cf.* Functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. *See* Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility ("Guidelines"), 1300 Off. Gaz. Pat. Office 142 (November 22, 2005), especially pages 151-152. (The Manual of Patent Examining Procedure includes substantively the same guidance. *See* MPEP, 8th edition (revised Aug. 2006), § 2106.01.)

Thus, Appellant's argument urging patentability is predicated on non-functional descriptive material. For these reasons, we sustain the Examiner's rejection of claim 51.

Dependent claims 43-45, 47, 49, and 50

Appellant fails to advance arguments regarding the remaining dependent claims. If an Appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. *Ex parte Frye*, No. 2009-006013, 2010 WL 889747, at *4 (BPAI Feb. 26, 2010) (precedential) (citing, *inter alia*, *Hyatt v. Dudas*, 551 F.3d 1307, 1313-14 (Fed. Cir. 2008) (the Board may treat arguments Appellant failed to make for a given ground of rejection as waived)). Because arguments not made are considered waived, we sustain the Examiner's rejection of remaining dependent claims 43-45, 47, 49, and 50.

CONCLUSION OF LAW

The Examiner did not err in rejecting claims 39-51 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's decision rejected claims 39-51 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

ORDER

<u>AFFIRMED</u>

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